

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: WILLIAM ALLOCCA *et al.*

APPLICATION No.: 09/547,540

FILED: APRIL 12, 2000

FOR: **PLACING A PURCHASE ORDER USING
ONE OF MULTIPLE PROCUREMENT
OPTIONS**

APPEAL No.: 2007-1327

EXAMINER: YOGESH C. GARG

ART UNIT: 3625

CONF. No: 5837

Mail Stop Appeal Brief - Patent
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

SUPPLEMENTAL REPLY BRIEF

Sir:

Appellant submits this Supplemental Reply Brief to discuss the recent Supreme Court opinion in *KSR Int'l v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), which supports appellant's contention that the claims are not obvious over the combination of Hartman and Yamada.*

The combination of Hartman's single-action ordering and Yamada's shopping cart would result in a system that allows single-action ordering and allows designation of multiple delivery addresses in a shopping cart. Such a combination might be considered to be a "combination of familiar elements according to known methods [that] is likely to be obvious [and that] does no more than yield predictable results." *Id.* at 1731. The combination might also be considered to be a simple arrangement of "old elements with each performing the same function it had been known to perform' and

* Appellant submits that the recent Supreme Court opinion is "good cause" for submitting this Supplemental Reply Brief to present new arguments. 37 C.F.R. § 41.37. Such an opinion is "a pertinent decision of a court or other tribunal [that] was not published until after the brief or reply brief was filed." M.P.E.P. § 1205.2.

yields no more than one would expect from such an arrangement." *Id.* at 1740 (citation omitted).

Appellant's claims are directed to an invention, however, that is not a simple combination of known elements such as combining Yamada's shopping cart with Hartman's single-action ordering. Rather, appellant's invention as recited, for example, by claim 1 is directed to the interplay between selecting a displayed element representing order fulfillment instructions for an item, displaying indications of multiple order fulfillment information, and, after selection of a displayed indication and "without further intervention by the user," sending a request to order the item based on the selected indication.

The Supreme Court recognizes that "it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements **in the way the claimed new invention does.**" *Id.* at 1741 (emphasis added). Although the Examiner provides a purported motivation for combining Hartman and Yamada, the Examiner has not provided any reason that would have prompted one to combine the elements as recited by appellant's claims. The Examiner simply states that "it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Hartman to display multiple groups/procurement options having information related to ordering the identified item as **expressly taught** in Yamada." Examiner's Answer, p. 5 (emphasis added). Yamada "expressly" teaches using multiple delivery addresses in a shopping cart. Neither Yamada nor Hartman teaches to combine the elements as recited by the claims and the Examiner has identified no reason to do so.

The Supreme Court also recognizes that "[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions" and this leads a person of ordinary skill to the anticipated success, then "the product [is] not of innovation." *Id.* at 1742. The Examiner has not, however, demonstrated such "market pressure" or "predictable solutions" relating to ordering using single-action ordering or using a shopping cart. Assuming that there was some market pressure for allowing multiple delivery addresses when ordering, the

"predictable solution[]" would be to add multiple delivery addresses to Hartman's shopping cart, which the Examiner recognizes is "expressly" taught by Yamada.

For the reasons outlined in appellant's Appeal Brief, Reply Brief, and this Supplemental Reply Brief, appellant requests that the rejection of the claims be reversed.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0665 under Order No. 249768019US2 from which the undersigned is authorized to draw.

Dated: 8-27-07

Respectfully submitted,

By Maurice J. Pirio
Maurice J. Pirio
Registration No.: 33,273
PERKINS COIE LLP
P.O. Box 1247
Seattle, Washington 98111-1247
(206) 359-8548
(206) 359-9548 (fax)
Attorney for Appellant